

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Gray in the May 6 telephone interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

I. The Drawings Satisfy all Formal Requirements

The Office Action objects to Figs. 18a-c and 19-22 as not being designated by the legend "Prior Art." Figs. 18a-c and 19-22 are corrected by the attached Request for Approval of Drawing Corrections to obviate the objection. Withdrawal of the objection to the drawings is respectfully requested.

II. Restriction Requirement

As indicated in the Confirmation of Telephone Election filed October 25, 2001, Applicants provisionally elect Group III, claims 12-17, with traverse.

It is respectfully submitted that the subject matter of all claims 1-17 is sufficiently related that a thorough search for the subject matter of any one Group of claims would encompass a search for the subject matter of the remaining claims. Thus, it is respectfully submitted that the search and examination of the entire application could be made without serious burden. See MPEP §803 in which it is stated that "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions" (emphasis added). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

Thus, withdrawal of the Restriction Requirement is respectfully requested.

### III. The Claims Define Allowable Subject Matter

The Office Action rejects claims 12, 14 and 15 under 35 U.S.C. §103(a) as unpatentable over JP 2726856 ("JP '856") in view of U.S. Patent No. 5,620,544 to Cram et al. ("Cram"); claim 13 under 35 U.S.C. §103(a) as unpatentable over JP '856, Cram and further in view of JP 9-226197 ("JP '197"); and claims 12-17 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 4,339,294 to Jones ("Jones") in view of Cram. These rejections are respectfully traversed.

With respect to claims 12 and 16, the applied art does not teach or suggest a process for producing a roll including, "printing a desired item on a surface of said adhesive film," as recited in independent claims 12 and 16. The Office Action admits that JP '856 does not teach printing a desired item on a surface of the winding terminal position on film t. Additionally, the Office Action admits that Jones does not teach printing a desired item on a desired item on a surface of the winding terminal position on the adhesive film.

However, the Office Action asserts that Cram makes up for this deficiency, since Cram teaches a tab at the end of a roll of web where the tab is the winding terminal position of the roll. Further, the Office Action asserts that the tabs have been printed with identifying indicia. Applicants respectfully disagree that Cram makes up for the deficiencies of both JP '856 and Jones. Specifically, Cram does not teach printing a desired item on a surface of said adhesive film, as recited in independent claims 12 and 16.

Instead, Cram discloses the liner/tab is provided with visual perceptible indicia 77 on one or both sides thereof. Additionally, the Office Action admits that the tabs have been printed with identifying indicia. Thus, Cram does not disclose printing a desired item on a surface of said adhesive film, because the tabs are already pre-printed.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §103 should be withdrawn because the applied art, whether taken singly or combined, do not teach or suggest each feature of independent claims 12 and 16.

MPEP §2143.03 instructs that "[t]o establish *prima facie* obviousness of a claimed invention, all the claimed limitations must be taught or suggested by the prior art. *In re Royka*, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)."

For at least these reasons, it is respectfully submitted that independent claims 12 and 16 are distinguishable over the applied art. The remainder of the claims that dependent from independent claims 12 and 16 are likewise distinguishable over the applied art for at least the reasons discussed above, as well as for the additional features they recite.

#### IV. Conclusion

For at least these reasons, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-17 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,



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JAO:JML/vgp

Attachments:

Petition for Extension of Time  
Request for Approval of Drawing Corrections

Date: May 13, 2003

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